

REMARKS

The Applicant has considered the Notice dated January 6, 2006. It is noted for the record that the identified error, i.e. that the claim numbering proceeded from claim 30 to claim 32, was contained in the application as originally filed on February 9, 2004, and therefore it is respectfully submitted that the amendment dated December 5, 2005 is not non-compliant, since it followed the original claim numbering of the application.

Nonetheless, to expedite prosecution of this application, the Applicant's counsel re-presents the amendment of December 5, 2005 in its entirety, with the claims renumbered. Specifically, former claim 32 (which is withdrawn from consideration) is now claim 31, former claim 33 is now claim 32, and so on. The withdrawn claims are amended also as needed to preserve the proper dependency. The claims presented in the response dated December 5, 2005 as new claims 35-48, which are the only claims currently under examination herein, are also renumbered as claims 34-47. Claims 34-47 are also amended as necessary to preserve the proper dependency. Because of this amendment, claims 34-47 are listed as "currently amended."

No mention was made in the Notice of any issues with the amendment to the Specification. However, for the Examiner's convenience those amendments are re-presented herein. Similarly, for convenience and to reflect the new claim numbering, the arguments and citations of case law previously submitted with the amendment of December 5, 2005 are again presented below for convenience.

Presented herein to replace claims 1-9 are new claims 34-39. It is noted that new claims 34-39 are presented for clarity (rather than as potentially confusing amendments to claims 1-3), and that no new matter is added by these claims. Claim 34 presents a generic formula for the Schiff base-containing compound (first structure) and the salen-ligand containing compound (second structure) of the present invention. Claim 35 presents a narrower generic formula for the salen-ligand containing compound of the invention. Claims 36-39 properly depend from claim 35. Support for these amendments is found in the Specification at page 4, lines 2-5 ("In another aspect, L may be a Schiff base-containing ligand.") and lines 5-8 ("In one embodiment, L may be a salen ligand which is bidentate, quadridentate, or greater."). See also Figures 1, 2, and 5 of the Specification as filed, which alone provide full support for the formulae presented in claims 34 and 35. Still further, original claims 1-3 (now canceled in favor of new claims 34-35) clearly state that L is a chelating ligand (claim 1) which may be a Schiff base-containing ligand (claim 2) or a salen ligand (claim 3). Minor revisions to the Specification are also provided to more fully present these generic formulas therein.

The Applicant also would draw the Examiner's attention to the fact that it is known in this art field that salen ligands are derivatives of Schiff bases, formed by reducing the Schiff base to change the double bond ($N=C$) into a single bond ($HN-C$). Accordingly, it is believed that the structures of claims 34-35 are entitled to examination. It is further believed that the amendments address fully the Examiner's rejections under

Section 112, 1st and 2d paragraph, and withdrawal of same is respectfully requested.

New claims 40-47 are presented herein also, directed to methods of use of the chemical compounds of claims 34-35. It is noted that these new claims are directed to the subject matter of original claims 10-34 (now 10-33), except as noted above relating to the chemical structures presented, and accordingly no new matter is added. Further, Examples 1-6 (pages 8-16) of the Specification as filed provide ample support for process claims 40-47. Because the process claims depend from what are believed to be allowable generic product claims (claims 34 and 35), rejoinder of these method claims is believed to be appropriate,¹ and is respectfully requested.

The Examiner argues that the open-ended term “comprising” in claims 1-2 renders claims 1-9 indefinite. It is believed that new claims 34 and 35 are not indefinite, and withdrawal of the rejection is respectfully requested.

Turning now to page 3 of the Office Action, the Examiner rejects the claims under 35 U.S.C. §102(a) over the Keizer et al. article in Canadian J. Chem. (2002), Vol. 80, No. 11, pp. 1463-68 (hereinafter the Keizer et al. article). In response, the Applicant respectfully traverses the rejection without amendment, on the grounds that the Keizer et al. article represents the Applicant’s own work. In support, a copy of the Affidavit under 37 C.F.R. 1.132, which was previously made of record with the amendment dated

¹ Manual of Patent Examining Procedure §821.04(a).

December 5, 2005, is presented. In accordance with the requirements of *In re Katz*,² the Affidavit establishes that: (1) David A. Atwood, the sole inventor of the subject matter of the present application, is a co-author of the cited Keitzer et al. article and that it describes his own work; and (2) Timothy S. Keizer, Lauren J. De Pue and Sean Parkin, also listed as co-authors on the Keitzer et al. article, are not considered inventors of any of the inventions claimed in the present patent application. Consequently, it is believed that this evidence removes the Keitzer et al. article as a reference under Section 102(a), since it conclusively establishes that the invention presented herein is not “by others” as required by that statute. Withdrawal of the rejection is respectfully requested.

It is believed that the amendments and arguments presented herein place the remaining claims of the present application in condition for allowance. Accordingly, reconsideration of the rejection of the claims, and allowance of all claims of the application is respectfully requested. If any issues remain, however, the Examiner is respectfully requested to contact the Applicants’ attorney at the telephone number of record in order to expedite the prosecution of this patent application.

Respectfully submitted,

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² *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

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Date 1/13/06 Robin Dennis